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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/039,260	03/16/98	ABERG A	4821-306

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EXAMINER	
CRANE, L	
ART UNIT	**PAPER NUMBER**
1623	14

DATE MAILED: 10/04/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/039,260	Applicant(s) Aberg et al.
	Examiner L. E. Crane	Group Art Unit 1623

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on 07/11/00 (Amdt B and IDS)

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 48, 50, 52-61 and 63-68 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 48, 50, 52-61 and 63-68 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

[x] Claims 1-14, 49, 51 and 62 have been cancelled.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 13 ☐ Interview Summary, PTO-413

☒ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other _____

Office Action Summary

U. S. Patent and Trademark Office
PTO-326 (Rev. 9-97)

Part of Paper No. 14

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group 1600, Art Unit 1623.

Claims 1-14 have been cancelled as per an application document filed March 16, 1998, claims 49, 51 and 62 have been cancelled, and new claims 63-68 have been added as per the amendment filed July 11, 2000. An Information Disclosure Statement (IDS), filed July 11, 2000, and all listed references have also been received and made of record.

Claims 48, 50, 52-61 and 63-68 remain in the case.

Note to applicant: Claims 60-61 presently show alternative dependence on claims 54-59, but would be more clear in this regard if both preambles read: -- The pharmaceutical composition of any one of claims 54-59... --.

Claim 65 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 65, the term "elixir" is a term which applicant uses in a manner suggesting the meaning is synonymous with -- pharmaceutical composition --. However, examination of Taber's Cyclopedic Medical Dictionary (17th Edition, 1993, F.A. Davis Company, Philadelphia, PA) provides the following definition for the term "elixir:" "a sweetened, aromatic, hydro-alcoholic liquid used in the compounding of oral medicines." Hence, the term "elixir" is really synonymous with "pharmaceutically acceptable carrier or excipient," thereby rendering the

instant claim improperly styled because of the improperly used term "elixir." If amended as suggested (replace "elixir" with -- pharmaceutical composition --), said claim would be a properly styled claim. Instant art rejections assume this change for the purposes of expediting prosecution.

Applicant's arguments with respect to claims 48-62 have been considered but are deemed to be moot in view of the new grounds of rejection.

Claim 50 lacks proper antecedent basis because it depends from now cancelled claim 49. The instant art rejection assume dependence from amended claim 48 was intended.

Applicant's arguments with respect to claims 48-62 have been considered but are deemed to be moot in view of the new grounds of rejection.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent."

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States."

Claims 48, 50, 52-54, 60-61 and 63-65 are rejected under 35 U.S.C. §102(b) as being anticipated by Villani et al. (PTO-1449 ref. AC)

wherein Berkow et al. (PTO-892 ref. R) is only cited to provide the definition of a specific compound well known in the art to be a "decongestant" commonly used in binary pharmaceutical compositions in combination with an antihistamine.

In the Villani et al. reference at column 8, lines 42-46, the combination of DCL and an decongestant in a single pharmaceutical composition is generically taught. The Berkow reference discloses at p. 326 under the heading "Treatment," lines 1-6, in particular lines 4-6, the combination of an antihistamine with the decongestant "pseudoephedrine" in a single pharmaceutical composition. This teaching represents no more than an exemplification of the generic "antihistamine + decongestant" teaching in the Villani reference.

Applicant's arguments filed July 11, 2000 have been fully considered but they are not deemed to be persuasive.

Applicant alleges that "Villani ... does not disclose even one pharmaceutical composition that contains a specific 7- or 8-(halo or trifluoromethyl)-substituted-6,11-dihydro-11-(4-piperidylidene)-5H-benzo[5,6]cyclohepta-[1,2-b]pyridine." Examiner respectfully disagrees. Applicant is referred to column 9, Table 1 and to claims *7 and 8* wherein pharmaceutical compositions are taught which fit applicant's definition. Applicant then argues that Villani does not teach pharmaceutical compositions containing specific proportions, a conclusion which is again incorrect: see again Table 1 at column 9. Applicant's subsequent arguments reliance on the incorrect conclusions noted herein render said arguments lacking in factual basis and therefore are deemed to be unpersuasive. Applicant also argues that examiner has combined Villani and Berkow et al. Examiner respectfully disagrees, directing applicant's

attention to the grounds of rejection which plainly states that Berkow is cited only to provide an example of a specific decongestant typically found in pharmaceutical compositions containing antihistamines and decongestants as taught by Villani. Applicant also argues that Villani is missing a limitation found in the instant cited claims. Examiner respectfully disagrees. Villani et al. specifically discloses pharmaceutical compositions comprising DCL and a decongestant, a disclosure which clearly meets the standard cited by applicant: " ... each and every element as set forth in the claim is found either expressly or inherently described, in a single prior art reference." For these reasons the instant rejection has been maintained.

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

Claims 48, 50, 52-54, 60-61 and 63-65 are rejected under 35 U.S.C. §103(a) as being unpatentable over Villani et al. (PTO-1449 ref. AC) in view of Berkow et al. (PTO-892 ref. R).

Villani et al. discloses at column 8, lines 42-46, the combination of DCL and an decongestant in a single pharmaceutical composition is generically taught. This reference does not disclose pharmaceutical compositions wherein the specific decongestant has been specified.

Berkow et al. discloses at p. 326 under the heading "Treatment," lines 1-6, in particular lines 4-6, the combination of an antihistamine with the

decongestant "pseudoephedrine" in a single pharmaceutical composition. This reference does not disclose pharmaceutical compositions wherein DCL and any one decongestant have been specified as the active ingredients.

The noted teaching of the Villani reference clearly motivates the ordinary practitioner to go out and find a decongestant to combine with DCL in a binary pharmaceutical composition. For this reason the instant claims are deemed to lack patentable distinction in view of the noted prior art references which do all but teach the specific combination active ingredients specified in claim 54.

Therefore, the instant claimed binary pharmaceutical compositions comprising DCL and a decongestant, pseudoephedrine in particular, would have been obvious to one of ordinary skill in the art having the above cited references before him at the time the invention was made.

Applicant's arguments filed July 11, 2000 have been fully considered but they are not deemed to be persuasive.

Applicant's arguments are couched as a response to an obviousness rejection, but rely on similar lines of reasoning as the responded to in the previous rejection. It is plain that Villani teaches the combination of DCL with any decongestant, a clear motivation for the ordinary practitioner to seek a decongestant. The rejection's citation of Berkow plainly provides an overlapping of disclosures and the specific example of pseudoephedrine as a decongestant commonly combined with an antihistamine in pharmaceutical compositions. Therefore, applicant is referred to the response to applicant's arguments found following the previous rejection. For the reasons noted herein and in the previous response to applicant's arguments above, the instant grounds of rejection have been maintained.

Claims 55-61 and 66-68 are rejected under 35 U.S.C. §103(a) as being unpatentable over Villani et al. (PTO-1449 reference AC) in view of Gennaro et al. (PTO-892 reference S).

The instant claims are directed to pharmaceutical compositions comprising DCL and an analgesic selected from the group consisting of acetylsalicylic acid, acetaminophen, ibuprofen, ketoprofen and naproxen.

The Villani et al. reference at column 8, lines 42-46, the combination of DCL and "other therapeutic agents" in a single pharmaceutical composition of the kind found in claims *5-8*, particularly claim *5* which is directed to "an antihistaminic pharmaceutical composition comprising ... [DCL] ... ." This reference does not teach the specific combination of DCL and an analgesic.

The Gennaro et al. reference discloses at p. 1131, column 2, numerous binary and ternary pharmaceutical compositions which contain antihistaminic activity and a mild analgesic, "acetaminophen" in particular being specified in the fourth, seventh and eighth compositions listed. Looking elsewhere in the same reference, one finds beginning at p. 1109 an extensive listing of "Analgesics and Antipyretics" with the following compounds listed at the page in parentheses following each name:
i) acetylsalicylic acid (aka aspirin, p. 1110),
ii) acetaminophen (p. 1109),
iii) ibuprofen (p. 1116),
iv) ketoprofen (p. 1112) and
v) naproxen (p. 1118). At p. 1109, column 2, this references states concerning the complete listing of compounds which follows that "... Most of these agents affect both pain and fever. Consequently they are used

widely for minor aches and pains, headaches and the general feeling of malaise that accompanies febrile illness, ..." This reference does not teach the specific combination of DCL and an analgesic.

The teaching of the Villani et al. reference motivates the combination of the antihistamine DCL with other medicinal agents in binary pharmaceutical compositions of the kind specifically embodied at p. 1131 of the Genarro et al. reference. The substitution of DCL for an antihistamine and the substitution of a different mildly analgesic substance for acetaminophen are therefore deemed to have been variations well within the purview of the ordinary practitioner seeking to optimize the efficacy of the antihistiminic-analgesic binary composition when the antihistamine is DCL. And, while Villani does not specifically teach combinations of DCL with analgesics, the Gennaro reference makes plain by its examples and other teachings that such combinations are notoriously well known and accepted variations in the pharmaceutical composition art, and are widely used to treat mild allergy-related nasal congestion.

Therefore, the instant claimed antihistaminic pharmaceutical compositions comprising DCL and an analgesic selected from the group consisting of acetylsalicylic acid, acetaminophen, ibuprofen, ketoprofen and naproxen would have been obvious to one of ordinary skill in the art having the above cited references before him at the time the invention was made.

Applicant's arguments filed July 11, 2000 have been fully considered but they are not deemed to be persuasive.

Applicant argues that "Villani provides no disclosure or suggestion of a pharmaceutical composition comprising the *specific* compound DCL,"

(emphasis as in original). Examiner respectfully disagrees. Applicant is directed to column 9, Table 1 and to claims *7 and 8* wherein specific DCL-containing pharmaceutical compositions are disclosed and claimed. Applicant then argues that Villani does not disclose a pharmaceutical composition containing DCL and either a non-steroidal antiinflammatory agent or a non-steroidal analgesic. Examiner agrees that this specific disclosure has not been made and notes that the rejection of record does not so allege. However, when applicant argues that "Villani ... does not even remotely suggest the specific combination of of DCL and a non-steroidal antiinflammatory agent or a non-steroidal analgesic," examiner respectfully disagrees. Villani plainly teaches pharmaceutical compositions comprising "DCL and other therapeutic agents." Applicant's then argue that only "impermissible hindsight" would permit the combination of the Villani and Gennaro reference, a conclusion with which examiner respectfully disagrees. DCL is plainly an "antihistamine," a fact which would guide the ordinary practitioner to seek disclosures which provide guidance concerning the administration of an "antihistamine" with other "therapeutic agents," the very kind of guidance provided by the Gennaro et al. reference. Therefore, the combination of references has been properly motivated by the type of pharmacological effects generally associated with antihistamine administration in combination with other "therapeutic agents." Applicant then argues that the combination of Villani and Gennaro et al. represents an "obvious to try" situation, implying that the art of binary antihistamine-containing pharmaceutical composition development is unpredictable. Examiner does not know of any teaching in Gennaro et al. or elsewhere to support this point of view, but openly solicits submission of all such relevant teachings which may be known, or may become known, to applicant. And finally, applicant argues that the instant combination of references permits the ordinary

practitioner to "impermissibly 'pick and chose'" the DCL of Villani and the analgesics of Gennaro et al. Examiner respectfully disagrees. The term "pick and chose" is an unfair characterization of the instant combination of references, because Gennaro et al. does not have unlimited selection of other "therapeutic agents" which may be combined with an antihistamine such as DCL. Therefore, applicant's arguments are deemed to be unpersuasive, and therefore to have failed to overcome the weight of the rejection of record. For these reasons the instant grounds of rejection have been maintained.

Applicant's amendment necessitated the new grounds of rejection. Accordingly, THIS ACTION IS MADE FINAL. See MPEP 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. §1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Papers related to this application may be submitted to Group 1600 via facsimile transmission(FAX). The transmission of such papers must conform with the notice published in the Official Gazette (1096 OG 30,

November 15, 1989). The telephone numbers for the FAX machines operated by Group 1600 are (703) 308-4556 and 703-305-3592 .

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner L. E. Crane whose telephone number is 703-308-4639 . The examiner can normally be reached between 9:30 AM and 5:00 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Gary Geist, can be reached at (703)-308-1701.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is 703-308-1235 .

LECrane:lec
09/27/00

GARY GEIST
SUPERVISORY PATENT EXAMINER
TECH CENTER 1600